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One PPG Place
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EXAMINER

WOLLSCHLAGER, JEFFREY MICHAEL

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH M. FERENCZ
and VINCENT A. GASPAR

Appeal 2008-005786
Application 10/809,595
Technology Center 1700

Decided: September 21, 2009

Before CHUNG K. PAK, CHARLES F. WARREN, and
TERRY J. OWENS, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 1 through 14 in the Office Action mailed October 17, 2006. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2006).

We reverse the decision of the Primary Examiner.

Claim 1 illustrates Appellants' invention of a process for manufacturing powder coatings, and is representative of the claims on appeal:

1. A process for manufacturing powder coatings comprising:

A) feeding starting materials to an extruder;

B) shear mixing the starting materials at ambient temperature in a first portion of the extruder; and

C) melt mixing the material from step B in a second portion of the extruder so as to achieve a melt mix, wherein the starting materials comprise a resin and a crosslinking agent.

The Examiner relies upon the evidence in these references (Ans. 3):¹

Williams	US 5,844,071	Dec. 1, 1998
Sherman	WO 98/17726	April 30, 1998
Giezen	WO 00/69916	Nov. 23, 2000

Appellants request review of the following grounds of rejection advanced on appeal by the Examiner (App. Br. 3):

claims 1, 2, 6 through 9, 12, and 13 under 35 U.S.C. § 102(b) over Giezen (Ans. 3);

claims 1, 2, 6 through 9, and 13 under 35 U.S.C. § 102(b) over Sherman (Ans. 5);

claims 1, 2, 6, 7, 9, and 13 under 35 U.S.C. § 102(b) over Williams (Ans. 5);

claims 3 through 5, 10, and 11 under 35 U.S.C. § 103(a) over Giezen as applied to claims 1, 2, 6 through 9, 12, and 13 (Ans. 6);

claims 3 through 5, 10, and 11 under 35 U.S.C. § 103(a) over Sherman as applied to claims 3 through 5, 10, and 11 (Ans. 7);

claims 3 through 5, 10, and 11 under 35 U.S.C. § 103(a) over Williams as applied to claims 1, 2, 6, 7, 9, and 13 (Ans. 8);

¹ We consider the Appeal Brief filed May 29, 2007, the Examiner's Answer mailed September 21, 2007, and the Reply Brief filed November 20, 2007.

claims 12 and 14 under 35 U.S.C. § 103(a) over Sherman as applied to claims 1, 2, 6 through 9, and 13 (Ans. 8); and

claim 14 under 35 U.S.C. § 103(a) over Giezen as applied to claims 1, 2, 6 through 9, 12, and 13 (Ans. 9).

Opinion

The dispositive issues in this appeal are whether Appellants have shown that the processes in appealed independent claims 1 and 9 specify the manufacture of “powder coatings” and manufacture “powder coating compositions” wherein the terms “powder coatings” and “powder coating” have the common meaning associated with the term “powder coatings” by one of ordinary skill in the coating arts, and whether Appellants have established that the evidence in each of Giezen, Sherman, and Williams does not describe methods capable of manufacturing “powder coatings” and “powder coating compositions” as specified by claims 1 and 9.

Claim interpretation

Considering first the interpretation of the appealed claims, we agree with Appellants that the terms “powder coatings” and “powder coating compositions” in appealed independent claims 1 and 9, respectively, must be given their broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art in light of the written description in the Specification. App. Br. 5-6; Reply Br. 4-5. *See, e.g., In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1378-79 (Fed. Cir. 2007); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004), and cases cited therein; *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). On this record, it would be readily apparent to

this person that these terms as used in the claims and in the Specification refer to powder coating techniques wherein a resin powder is applied to a surface in powder form as is well known in the art.² See Spec., e.g., ¶¶ 0002-0004 and 0020-0021.

Furthermore, on this record, and contrary to the Examiner's position, we agree with Appellants that it is clear from the language in the preamble and the body of claims 1 and 9 and in the disclosure in the Specification, that the preambular language in claims 1 and 9 must be given weight with respect to the processes encompassed thereby. Ans. 10-12; App. Br. 4 and 8-9; Reply Br. 2-4. In this respect, we determine the language "wherein starting materials comprise a resin and a crosslinking agent" in the body of claims 1 and 9 necessarily refers to "a process for manufacturing powder coating" and "a process for manufacturing powder coating compositions" in the preamble of claims 1 and 9, respectively, for identification of the "starting materials." See Spec., e.g., 3:10-14. See, e.g., *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999); *Corning Glass Works v. Sumitomo Elect. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989); *In re Stencel*, 828 F.2d 751, 754-55 (Fed. Cir. 1987), and cases cited therein ("Whether a [statement] . . . of intended purpose constitutes a limitation to the claims is, as has long been established, a matter to be determined on the facts of each case in view of the claimed invention as a whole.").

² See, e.g., Zeno. W. Wicks, Jr., "Powder Coatings," *Coatings*, Kirk-Othmer Encyclopedia of Chemical Technology, 6, 731-33 (4th ed., John Wiley & Sons, 1993).

Thus, on this record, we interpret appealed independent claims 1 and 9 to encompass any processes capable of manufacturing any manner of “powder coatings” and “powder coating compositions.”

Grounds of Rejection

Turning now to consideration of the grounds of rejection, we agree with Appellants that the evidence in each of Giezen, Sherman, and Williams does not describe methods capable of manufacturing “powder coatings” and “powder coating compositions” as specified by claims 1 and 9.

In this respect, there is no dispute that, as a matter of fact, each of Giezen, Sherman, and Williams discloses processes which include steps of feeding starting materials to an extruder; shear mixing the starting materials at ambient temperature in a first part of the extruder; and melt mixing the material in a second portion of the extruder to form a melt mix, wherein the starting materials comprise a resin and a crosslinking agent. App. Br. 9-13; Ans. 10. However, there is also no dispute that, as a matter of fact, none of Giezen, Sherman, and Williams disclose processes of manufacturing materials which are taught to function as “powder coatings” and “powder coating compositions” as we have interpreted these claim terms above. App. Br. 9-13; Reply Br. 5-6.

Indeed, the Examiner acknowledges that Williams discloses ink compositions using resins which can be in powdered form, and Giezen discloses using nanoparticles in resin coating compositions. Ans. 12, citing Williams, abstract, col. 6, ll. 8-24, and col. 7, ll. 13-30; and Giezen, p. 3, ¶ 0013. The Examiner further acknowledges that Sherman discloses “a method of making polymer mixtures,” which we find are disclosed in the

reference to be useful for, among other things, plastics, adhesives, and vibration damping compositions. Ans. 5; Sherman, e.g., 1:5-9. On this record, the Examiner has not established that the processes of Giezen, Sherman, and Williams manufacture “powder coatings” and “powder coating compositions” as specified by the appealed claims.

Accordingly, in the absence of a prima facie case of anticipation and/or of obviousness made out over Giezen, Sherman, and/or Williams, we reverse the grounds of rejection under 35 U.S.C. §§ 102(b) and 103(a) advanced on appeal.

The Primary Examiner’s decision is reversed.

REVERSED

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